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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/695,259
Filing Date: October 27, 2003
Appellant(s): TAN, WAI-TIAN

John P. Wagner, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 3, 2010 appealing from the Office action mailed November 30, 2009.

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(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-33 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

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REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

NEW GROUND(S) OF REJECTION

Claims 12-22 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. See rejection herein below.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

2002/0156842	Signes et al.	10-2002
6,785,704	McCanne	8-2004

(9) Grounds of Rejection

I. The following new ground(s) of rejection are applicable to the appealed claims:

A. Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 12-22 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable or

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useable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instruction for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals *per se*, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claims. Cf. *Animals – Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (suggesting that applicants add the limitation “non-human” to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal *per se* is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. See, e.g., *Gentry Gallery, Inc v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).

In this instance, Claim 12 recites [a] *computer useable medium* which can be broadly and reasonably interpreted to cover both non-statutory and statutory subject matter.

Since the dependent claims 13-22 incorporate the above deficiency, they are also rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

II. The following current ground(s) of rejection are applicable to the appealed claims:

B. Claim Rejections – 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1-6, 8, 11-17, 19, 22-28, 30 and 33 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0156842 by Signes et al. (“Signes”).

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions or descriptions of embodiments that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not therefore be considered to be that of new grounds of rejection.

Claim 1

Signes discloses at least *a method for dynamically configuring a network component, comprising:*

receiving a request for content from a first network connected component (see at least FIG. 2, step 230 and [0024]);

determining a type of media service needed for at least a portion of said content to fulfill said request (see at least FIG. 2, steps 235-240-245 and [0024]; e.g., identifying appropriate media that is responsive to the placeholder and identification of the client terminal 150); and

configuring a data relaying component to forward said at least a portion of said content from a second network connected component to a third network connected component, said portion of said content to receive said type of media service performed by said third network connected component (see at least FIG. 2, steps 245-250 and [0021-0024]).

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Claim 2

The rejection of base claim 1 is incorporated. Signes further discloses *wherein said step of receiving said request for content is performed by a network connected server* (see at least FIG. 1, device 130).

Claim 3

The rejection of base claim 1 is incorporated. Signes further discloses *wherein said request is for streaming media content* (see at least [0024]; e.g., the streaming requests).

Claim 4

The rejection of base claim 1 is incorporated. Signes further discloses *wherein said first network connected component is a client device* (see at least FIG. 1, device 150).

Claim 5

The rejection of base claim 1 is incorporated. Signes further discloses *wherein said second network connected component is a content server* (see at least FIG. 1, device 130).

Claim 6

The rejection of base claim 1 is incorporated. Signes further discloses *wherein said third network connected component is a media service component which receives said content, performs a media service and transmits the content to a client device* (see at least FIG. 1, device 120).

Claim 8

The rejection of base claim 1 is incorporated. Signes further discloses *wherein said content is redirected to said third network connected component while en route to said first network connected component* (see at least FIG. 1 and [0024]; e.g., the requested media content ultimately reaches the client 150 via the streaming server 120).

Claim 11

The rejection of base claim 1 is incorporated. Signes further discloses *wherein said server receives said request routed by said data relaying component, and supplies routing configuration instructions to said data relaying component to create or destroy a rule to route selected streams to a media service* (see at least [0024]; e.g., redirecting the streaming requests to adequate streaming server 120).

Claim 12

Since Claim 12 is an independent claim that recites *a computer useable medium having computer useable code embodied therein causing a computer to perform* the same operations of method claim 1, the same rejection is thus applied.

Claim 13

The rejection of base claim 12 is incorporated. Since Claim 13 recites the same feature of Claim 2, the same rejection is thus applied.

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Claim 14

The rejection of base claim 12 is incorporated. Since Claim 14 recites the same feature of Claim 3, the same rejection is thus applied.

Claim 15

The rejection of base claim 12 is incorporated. Since Claim 15 recites the same feature of Claim 4, the same rejection is thus applied.

Claim 16

The rejection of base claim 12 is incorporated. Since Claim 16 recites the same feature of Claim 5, the same rejection is thus applied.

Claim 17

The rejection of base claim 12 is incorporated. Since Claim 17 recites the same feature of Claim 6, the same rejection is thus applied.

Claim 19

The rejection of base claim 12 is incorporated. Since Claim 19 recites the same feature of Claim 8, the same rejection is thus applied.

Claim 22

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The rejection of base claim 12 is incorporated. Since Claim 22 recites the same feature of Claim 11, the same rejection is thus applied.

Claim 23

Since Claim 23 is an independent claim that recites *a server* (Signes; see at least FIG. 1, device 130) *comprising*:

memory for storing a request for content from a first network connected component; and

a processor coupled to said memory for performing the same operations recited in method claim 1, the same rejection is thus applied.

It should be noted that a server is a computer comprising memory, such as RAM, ROM, and different storage medium (e.g., hard-drive, etc.) and one or more microprocessors. These components are deemed inherent to Signes because without these components, the server disclosed by Signes would be inoperable.

Claim 24

The rejection of base claim 23 is incorporated. Since Claim 24 recites the same feature of Claim 2, the same rejection is thus applied.

Claim 25

The rejection of base claim 23 is incorporated. Since Claim 25 recites the same feature of Claim 3, the same rejection is thus applied.

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Claim 26

The rejection of base claim 23 is incorporated. Since Claim 26 recites the same feature of Claim 4, the same rejection is thus applied.

Claim 27

The rejection of base claim 23 is incorporated. Since Claim 27 recites the same feature of Claim 5, the same rejection is thus applied.

Claim 28

The rejection of base claim 23 is incorporated. Since Claim 28 recites the same feature of Claim 6, the same rejection is thus applied.

Claim 30

The rejection of base claim 23 is incorporated. Since Claim 30 recites the same feature of Claim 8, the same rejection is thus applied.

Claim 33

The rejection of base claim 23 is incorporated. Since Claim 33 recites the same feature of Claim 11, the same rejection is thus applied.

C. Claim Rejections – 35 USC § 103

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1. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 9-10, 18, 20-21, 29 and 31-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0156842 by Signes et al. (“Signes”) in view of U.S. Patent No. 6,785,704 to McCanne.

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions or descriptions of embodiments that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not therefore be considered to be that of new grounds of rejection.

Claim 7

The rejection of base claim 1 is incorporated. Signes does not specifically disclose *wherein said configuring is performed by a real time streaming protocol (RTSP) server.*

However, in an analogous art, McCanne discloses an application-specific connection request such as RSTP (see at least 20:1-13; 25:43-56; 28:9-51; 29:5-32), which helps avoid media server’s stale redirection decision which is unacceptable for streaming media traffic (19:37-41).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the RSTP for the media server 130 of Signes for the purpose discussed above.

Claim 9

The rejection of base claim 1 is incorporated. Signes does not specifically disclose *wherein said request is redirected using Internet domain name service (DNS) based redirection techniques.*

However, in an analogous art, McCanne discloses that redirecting can be done using a domain name service (DNS) in case the local servers are fully loaded (see at least Abstract and 13:36-51).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the capability of redirecting requests for media content as taught in McCanne for the purpose discussed above.

Claim 10

The rejection of base claim 1 is incorporated. Signes does not specifically disclose *wherein said content or request is redirected using a web cache communication protocol (WCCP) routing mechanism.*

However, in an analogous art, McCanne discloses that Web cache media server can be extended with simple rules for how to resolve the content request via the conventions in the URL so that a redirection-aware Web cache could parse the URL path and determine which particular Web server it should go to pull down the content (see at least 23:4-67).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the Web cache routing mechanism as taught in McCanne so that content can be pull down content faster since the content is already in cache.

Claim 18

The rejection of base claim 12 is incorporated. Since Claim 18 recites the same feature of Claim 7, the same rejection is thus applied.

Claim 20

The rejection of base claim 12 is incorporated. Since Claim 20 recites the same feature of Claim 9, the same rejection is thus applied.

Claim 21

The rejection of base claim 12 is incorporated. Since Claim 21 recites the same feature of Claim 10, the same rejection is thus applied.

Claim 29

The rejection of base claim 23 is incorporated. Since Claim 29 recites the same feature of Claim 7, the same rejection is thus applied.

Claim 31

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The rejection of base claim 23 is incorporated. Since Claim 31 recites the same feature of Claim 9, the same rejection is thus applied.

Claim 32

The rejection of base claim 23 is incorporated. Since Claim 32 recites the same feature of Claim 10, the same rejection is thus applied.

(10) Response to Argument

1. Whether Claims 1-6, 8, 11-17, 19, 22-28, 30 and 33 are anticipated by Signes.

Appellant's essential arguments

The instant Office Action states that Signes discloses the features of Appellant's Claim 1. Appellant respectfully submits that Signes does not anticipate the features of Claim 1.

Appellant understands Signes to disclose a "system for audio-visual media customization according to receiver attributes" (Signes, Title) in which a "rule engine looks to the content database 134 to determine a particular media content that is responsive to the request" (Signes, paragraph [0040]). This "media content" is linked to the attributes of the intended receiver (Signes, paragraph [0039].) such as "local advertising based upon geographical location of the end user" (Signes, paragraph [0041]) and "advertising tailored to a end users' interests, age, gender, language or profession" (Signes, paragraph [0042]). The "media content" is "customized information" (emphasis added; Signes, paragraph [0024]), not a media service. Signes' server 120 contains the personalized content that may be obtained.

Significantly, Signes remains silent as to "determining a type of media service needed for at least a portion of said content to fulfill said request" (Appellant's Claim 1) in order to overcome a situation in which a content server "can only provide [content] in an [sic] a format (e.g. audio) that the client device 501 is not equipped to accommodate" (Appellant's specification, page 12, lines 4-10). Thus, as Signes remains silent as to "determining a of media service needed" (emphasis added), Appellant respectfully asserts that Signes also remains silent as to:

configuring a data relaying component to forward said at least a portion of said content from a second network connected component to a third network connected component, said portion of said content to receive said type of media service performed by said third network connected component

Examiner's answer

a. The examiner respectfully disagrees with Appellant's assertion that Signes' "media content" is "customized information," not a media service. Rather, the claimed "media service" is interpreted by the Office to be Signes' streaming service performed by the streaming server 120 of Signes' FIG. 1.

b. Contrary to Appellant's assertion that Signes is silent as to "determining a type of media service needed for at least a portion of said content to fulfill said request" in order to

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overcome a situation in which a content server “can only provide [content] in a format (e.g., audio) that the client device 501 is not equipped to accommodate,” the examiner respectfully notes the following:

- i. the claimed determining a type of service needed is interpreted to be one of the steps performed by Signes' media server 130 which determines that the requested media content needs to be streamed and this type of streaming service is to be performed by a streaming server 120 (see at least FIG. 1, e.g., Media Server 130, Streaming Server 120; FIG. 2, step 245--streaming request and [0024]).
- ii. Appellant's arguments that the type of service that is needed is one that is used to overcome a situation in which a content server “can only provide [content] in a format (e.g., audio) that the client device 501 is not equipped to accommodate are considered to be arguments for features that are described in Appellant's specification and not specifically recited in the claim. Therefore, such arguments are considered moot.
- c. With respect to Appellant's assertion that Signes is silent as to the third limitation of Claim 1 (" configuring ... to forward ... from ... to ..."), the examiner respectfully notes the following:

Claimed feature	Signes' equivalent feature (see FIG. 1)
configuring ... to forward ... from ... to	processing ... to redirect streaming request to the adequate streaming server 120 (see [0024] and [0047])
a data relaying component	dispatcher 132
said at least portion of said content	content to go into a placeholder
second network connected component	media server 130
third network connected component	streaming server 120
Said portion of said content to receive said type of media service performed by said third network connected component	the customized media content to be streamed (i.e., the claimed type of media service) by the streaming server 120

Appellant's essential arguments

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In furtherance of this assertion, Appellant respectfully disagrees with the instant Office Action's analysis of the "equivalent" features of Signes and Appellant's Claim 1 (instant Office Action, page 3-4). Appellant respectfully directs the discussion to page 9, lines 19-27 (emphasis added) of Appellant's specification, which provides:

According to one embodiment, the RTSP server 503 is supplied with information that enables it to cause a redirection of packets that are initially slated to be transmitted directly from a first point on the network to a second point on the network (e.g., a content server to a client device.) to a third point on the network (e.g., media service provider). It should be appreciated that upon receiving a session initiation request from a client device (e.g., 501), the RTSP server 503 can configure a network switch to redirect designated packets to appropriate service locations.

Furthermore,

[m]edia service 507 is a network connected component that can perform designated services on streaming media content. The services that can be provided can include but are not limited to format conversion services such as display size, bit rate, compression standard for video, sampling rate, quality, and compression standard for audio. (Emphasis added; Appellant's specification, page 10, lines 1-5). As such, "media service" is defined as a component, in one embodiment, that provides format conversion services. The content is redirected to a media service 507 "when a request is made from a client device 501 to a content server 505 for content that the content server 505 can only provide in an [sic] a format (e.g., audio) that the client device 501 is not equipped to accommodate" (emphasis added; Appellant's specification, page 11, lines 3-9 and Figure 5).

Examiner's answer

It is noted that the features upon which appellant relies (i.e., RTSP server 503, packets redirection, session initiation request from a client device, network switch, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding arguments regarding media service 507, Appellant's attention is respectfully directed to the discussion set forth in the b) section of the examiner's answer above.

Appellant's essential arguments

Thus, according to Appellant's specification and Appellant's Claim 1, Appellant's "first network connected component" is the client 501. The "second network component" is content server 505. The "third network component" is the media service 507. The RTSP server 503 redirects the packets that were initially slated to be transmitted directly from the content server 505 (second network component) to client device 501 (first network component), to be transmitted to the media service 507 (third network component). The media service 507 performs a conversion service on the content, which converted content then is sent to client device 501.

In contradiction to Appellant's Claim 1 and as stated in the instant Office Action on pages 3-4, Signes' second network component is the media server 130 and its third network component is the streaming server 120. Furthermore, while not stated in the instant Office Action, based on the assignments given regarding the network components, Signes' first network component is the terminal 150 of end user 155. It is Signes' media server 130 that directs a request to a specific streaming server 120 according to a placeholder 116's (the placeholder 116 is within the content that accompanies the request from the end user 155) indications.

In contrast, it is Appellant's RTSP server 503, which is not defined as a first, second or third component and is thus not equivalent to Signes' media server 130 (second network component) in

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Appellant's Claim 1, that configures a data relaying component 511 to redirect content to its third network component, media server 507 for conversion services that provide content in a format that client 501 (first network component) is equipped to handle.

Appellant's media service 507 actually performs conversion services of the media and is the last stop before the converted content is sent to the client device 501. Signes' "media service" 130 merely directs a request for content to a server, which server (Signes' server 120) sends the requested content to end user 155 at terminal 150, regardless of the end user's 155 terminal's 150 ability to handle the format.

Examiner's answer

Appellant's claimed features	Signes' equivalent features (See FIG. 1)
First network connected component	Terminal 150
Second network connected component	Media Server 130
Third network connected component	Streaming Server 120

In response to Appellant's assertion that the RTSP server 503, which is neither defined as a first, second or third component, is the component that configures the data relaying component 511 to redirect content to the third network component in order for the media service component to process the content, it is respectfully noted that:

- i. the above-mentioned function of configuring is not specifically recited as being performed by the RTSP server 503; and
- ii. since the configuring function as recited in Claim 1 is not claimed to be performed by the RTSP server and since the recited configuring function appears to be similar to the function of Signes' media server 130, the interpretation set forth in the Office action as to the anticipation of the step of configuring by Signes' media server 130 is deemed proper.

In response to Appellant's arguments that it is Appellant's media service 507 that performs conversion services of the media, it is previously noted that this content conversion service (i.e., the streaming service) is performed as required by Appellant's claim requirement by Signes' streaming server 120 (i.e., the third network component) before the final product is being streamed to terminal 150.

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Appellant's essential arguments

Furthermore, Appellant's network data relaying component (e.g., switch, router, computer, etc.) 511 "is a network connected component that can be programmed to 'redirect' packets" (emphasis added, Appellant's specification, page 10, lines 7-8) and is separate from Appellant's RTSP server 503 (Appellant's Figure 5). In contrast, Signes' dispatcher 132 directs a request from the terminal 150 (end user 155) to a server 120 and is part of Signes' media server 130.

Examiner's answer

In response to Appellant's arguments, the examiner respectfully notes that Appellant's network data relaying such as switch, router, computer, etc. are separate from the RTSP server 503 are features that are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant's essential arguments

Appellant's "determining a type of media service" and redirecting content to a media service 507 that performs the media service determined to be needed enables a client to obtain requested content in a format that the client is equipped to accommodate (Appellant's Claim 1 and specification, page 12, lines 7-13). In contrast, Signes focuses on providing "customized media" (Signes, paragraph [0047]) to the terminal 150 in response to a request in the form of the following:

[0041] local advertising based upon geographical location of the end user

[0042] advertising tailored to a end users' interests, age, gender, language or profession

[0043] branding or access to specific services related to the end-user subscription [0044] updates on specific topics of interest to an end user such as sports scores [0045] product updates relating to products owned by the end user [0046] other information such as be of interest to the end user (Signes, paragraphs [0041] to [0046].) Significantly, Signes does not provide content to streaming server 120 that is slated to undergo format conversion services at that streaming server 120 in order that a client may receive the content in a format the client is equipped to accommodate, without which conversion services being performed the client would not be able to accommodate the content received.

Examiner's answer

In response to Appellant's arguments that the type of media service needed is to enable a client to obtain the requested content in a format that the client is equipped to accommodate, without which conversion services being performed the client would not be able to accommodate the content received, it is respectfully noted that the features upon which Appellant relies are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Appellant's essential arguments

Additionally, Appellant respectfully notes and asserts that as per the reasoning presented above, Appellant's Claim 8, "wherein said content is redirected to said third network connected component while en route to said first network connected component" (emphasis added) and Appellant's Claim 11, "wherein said [RTSP] server receives said request routed by said data relaying component, and supplies routing configuration instructions to said data relaying component to create or destroy a rule to route selected streams to a media service" are allowable. Moreover, Appellant's note that the "server" described in Appellant's Claim 11 is the RTSP server 503 of Figure 5, and that Claim 11 should read, "wherein the received request routed by said data relaying component" as opposed to "wherein said server receives said request routed by said data relaying component" as it is the RTSP Server 503 that performs the "receiving", "determining" and "configuring" of Appellant's Claim 1.

Examiner's answer

In response to Appellant's arguments regarding the rationale for the rejection of Claim 8, it is noted that Signes teaches that the requested content is redirected to the streaming server 120 while the requested content is destined to be sent to terminal 150 (see FIG. 2, step 245) as required by the claim requirement.

In response to Appellant's arguments regarding the rationale for the rejection of Claim 11, it is respectfully noted that:

- i. nowhere in Claim 11 is RTSP server 503 recited;
- ii. nowhere in Claim 11 is recited that the RTSP server is to receive, determine, and configure (the three steps recited in Claim 1); and
- iii. if Claim 11 should read "wherein the received request routed by said data relaying component" as opposed to "wherein said server receives said request routed by said data relaying component," Claim 11 should be explicitly amended as such.

Appellant's essential arguments

Thus, Appellant respectfully submits that Signes does not anticipate the features as are set forth in independent Claim 1, and as such, Claim 1 traverses the rejection under 35 U.S.C. § 102(b) and is condition for allowance. Accordingly, Appellant also respectfully submits that Claims 12 and 23 are in condition for allowance for the reasons stated herein with regards to Claim 1. Furthermore, Appellant respectfully asserts that Claims 2-6, 8 and 11 depending on Claim 1, Claims 13-17, 19 and 22 depending on Claim 12 and Claims 24- 28, 30 and 33 depending on Claim 23 are allowable as being dependent on an allowable base claim.

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Furthermore, Appellant respectfully asserts that Claims 8 and 11 are allowable independent of the determination of Claim 1's allowability.

Examiner's answer

According to the foregoing discussion, the rejection under 35 U.S.C. § 102(b) of Claims 1-6, 8, 11-17, 19, 22-28, 30 and 33 as being anticipated by Signes is considered to be proper.

2. Whether Claims 7, 9, 10, 18, 20, 21, 29, 31 and 32 are unpatentable under 35 U.S.C. § 103(a) over Signes in view of McCanne.

Appellant's essential arguments

Appellant respectfully submits that embodiments of Appellant's Claim 1 as a whole would not have been obvious, and therefore the instant Office Action does not satisfy the requirements for a rejection of Claim 1 under 35 U.S.C. § 103(a). In particular, Appellant respectfully submits that the instant Office Action fails to explain the differences between Signes, McCanne, and Appellant's claimed features. Moreover, Appellant respectfully submits that the instant Office Action fails to explain why these differences would have been obvious to one of ordinary skill in the art.

As stated herein, Appellant respectfully submits that Signes remains silent as to "determining a type of media service needed" as well as:

configuring a data relaying component to forward said at least a portion of said content from a second network connected component to a third network connected component, said portion of said content to receive said type of media service performed by said third network connected component

as is recited in Appellant's Claim 1. Furthermore, Appellant respectfully submits that McCanne fails to overcome the deficiencies of Signes. In particular, Appellant respectfully submits that McCanne also remains silent as to "determining a type of media service needed" as well as:

configuring a data relaying component to forward said at least a portion of said content from a second network connected component to a third network connected component, said portion of said content to receive said type of media service performed by said third network connected component

as is recited in Appellant's Claim 1. Appellant understands McCanne to disclose a "content distribution system for operation over an internetwork including content peering arrangements" (McCanne, Title) in which "a request for the content is sent from the client to a redirector node that receives requests, wherein a redirector at the redirector node provides an address for a server available to serve the requested content" (emphasis added; McCanne, Abstract). However, Appellant respectfully asserts that McCanne fails to disclose "determining a type of media service needed" as well as:

configuring a data relaying component to forward said at least a portion of said content from a second network connected component to a third network connected component, said portion of said content to receive said type of media service performed by said third network connected component

as is recited in Appellant's Claim 1. Moreover, Appellant respectfully asserts that nothing in McCanne provides a motivation to modify Signes to arrive at the features of Appellant's Claim 1.

Additionally, Appellant respectfully submits that the instant Office Action fails to explain why the differences between Signes, McCanne, and Appellant's features of Claim 1 would have been obvious to one of ordinary skill in the art.

Thus, in view of the combination of Signes and McCanne not satisfying the requirements of a prima facie case of obviousness, Appellant respectfully asserts that Claim 1 is patentable over Signes in view of McCanne. Additionally, Appellant respectfully submits that Claims 12 and 23 are patentable for the reasons stated herein with regards to Claim 1. Moreover, Appellant respectfully submits that Claims 7, 9 and 10 depending on Claim 1, Claims 18, 20 and 21 depending on Claim 12 and Claims 29, 31 and 32 depending on Claim 23 are in condition for allowance as being dependent on an allowable base claim.

Examiner's answer

In response to Appellant's arguments that the Office action fails to explain the differences between Signes, McCanne and Appellant's claimed features, it is respectfully noted that Appellant fails to specifically indicate where in the Office action (i.e., which claim and which features) that the Office action fails to explain the differences.

Contrary to Appellant's assertion, for each claim rejected under 35 U.S.C. § 103(a), the Office action has followed the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) which are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

For example, the rejection of Claim 7, *inter alia*, has been set forth according to the steps mentioned above:

1. "The rejection of base claim 1 has been incorporated" (i.e., determine the scope of the prior art).
2. "Signes does not specifically disclose *wherein said configuring is performed by a real time streaming protocol (RTSP) server*; however, in an analogous art, McCanne discloses an application-specific connection request such as RSTP (see at least 20:1-13; 25:43-56; 28:9-51; 29:5-32), which helps avoid media server's stale redirection decision which is unacceptable for streaming media traffic (19:37-41)" (i.e., ascertaining differences between the prior art and the claims at issue).
3. "It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the RSTP for the media server 130 of Signes" (i.e., resolving the level of ordinary skill in the pertinent art).
4. "for the purpose discussed above" (i.e., considering objective evidence present in the application indicating obviousness or nonobviousness).

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In response to Appellant's assertion that McCanne does not teach the indicated limitations, it is noted that these limitations are already taught by Signes.

In response to Appellant's assertion that nothing in McCanne provides a motivation to modify Signes to arrive at the features of Appellant's Claim 1, the examiner respectfully notes that:

- i. the motivation is provided (i.e., "which helps avoid media server's stale redirection decision which is unacceptable for streaming media traffic" supported in McCanne's specification at 19:37-41").
- ii. even assuming, *arguendo*, that the motivation to combine is not provided by the Office action, the examiner respectfully notes that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, -- USPQ2d --, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007)(citing *KSR*, 82 USPQ2d at 1396)(available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of

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rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Hoang-Vu Antony Nguyen-Ba/

Primary Examiner, Art Unit 2421

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Timothy P Callahan/

Director, Technology Center 2400

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Conferees:

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

/Andrew Y Koenig/
Supervisory Patent Examiner, Art Unit 2423